



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,604	08/19/2003	Marie K. Walsh	T9105.C	5579
20450	7590	05/16/2006	EXAMINER	
ALAN J. HOWARTH			WEIER, ANTHONY J	
P.O. BOX 1909			ART UNIT	
SANDY, UT 84091-1909			PAPER NUMBER	

1761

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,604

Applicant(s)

WALSH ET AL.

Examiner

Anthony Weier

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-119 is/are pending in the application.
- 4a) Of the above claim(s) 7-12, 27-55, 62-67, and 83-108 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13-26, 56-61, 68-82 and 109-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, Species 1a in the reply filed on 3/3/06 is acknowledged. The traversal is on the grounds that thermoplastic extrusion of the protein/polysaccharide mixture of the instant invention results in a product that is "at least significantly different in texture and density than a product produced in a static mold." However, there is no recitation of texture and density differences in the instant claims, and it is asserted that the product produced in a static mold would produce a product with attributes well within the scope of the claims as presently recited. Aside from the fact that Applicant's have submitted a very large number of claims (i.e. 119), Applicant argues that the search of all groups of claims would not present undue burden on the examiner. Examiner strongly disagrees as the search of all 119 claims would, in itself, present a serious search burden. In support, the search of each group presents a different field of search which are not fully commensurate with one another. Applicant notes that the classification of both groups in the same subclass is evidence of the lack of burden regarding the search of same. Quite the contrary, this simple classification of a single class and subclass for the purpose of the restriction requirement is not in any way evidence that this is the only class and subclass searched. Each invention extends into different areas of search and requires a different search strategy that would impart serious burden to the examiner particular under the constraints of the approximately 15.9 hour availed to him for working on this case.

It should be noted that by electing species 1a, claims 6 and 61 and the generic claims of Group I have been elected (i.e. claims 1-5, 13-26, 56-60, 68-82, and 109-119).

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 13-16, 22-26, 56-61, 68-71, 77-82, 109-113, and 119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldbrugge et al.

Feldbrugge et al discloses a texturized protein material produced by thermoplastic extrusion¹ wherein same contains whey which may be available in either concentrate or isolate form (e.g. col. 4, lines 3-21). It should be noted that Feldbrugge et al further discloses that a certain amount of the protein employed must be undenatured (see col. 3, line 64). Feldbrugge also discloses the use of wheat protein but is silent regarding the combination of, for example, wheat and whey proteins. However, since each protein component serves the same purpose, it would have been obvious to one having ordinary skill in the art at the time of the invention to have employed same together to serve the same purpose. It is obvious to combine two component each of which is taught by the prior art for the same purpose to form a third composition for the same purpose. In re Kerkhoven 205 USPQ 1069.

Feldbrugge et al further discloses the use of a pH adjusting agent by way of, for example, ammonium carbonate, and it would have been further obvious to have included same in products therein containing whey for the same reason.

Feldbrugge et al also discloses the inclusion of starch ingredients (col. 4, line 65) but is silent regarding the more specific use of cornstarch as claimed. However, cornstarch is notoriously well known, and, absent a showing of unexpected results, it would have been further obvious to have included same as a matter of preference depending on, for example, availability or cost.

The claims further call for particular amounts of the protein and polysaccharide components of the product. However, such determination would have been well within the purview of one having ordinary skill in the art, and it would have been obvious for said one at the time of the invention to have arrived at such amounts as a matter of preference depending on, for example, cost or availability of such ingredients.

The instant claims call for the inclusion of sweet whey. Although Feldbrugge et al discloses the use of whey in general, same is a notoriously well known type of whey, and it would have been further obvious to have employed sweet whey as a matter of preference in view of, for example, cost and availability.

4. Claims 17, 18, 72, 73, 114, and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldbrugge et al taken together with Villagran et al.

The claims further call for the inclusion of more specific polysaccharides and calcium ingredients not taught by Feldbrugge et al (e.g. pectin and calcium chloride).

¹ Morimoto et al refers to Feldbrugge et al for its thermoplastic extrusion process (see col. 1, lines 31-33).

However, it is known to employ such ingredients in extruded food products as taught, for example, by Villagran et al which teaches the inclusion of a variety of polysaccharide materials (carboxymethylcellulose, maltodextrin, pectin, etc.). It would have been obvious to one having ordinary skill in the art at the time of the invention to have employed such ingredients in the product of Feldbrugge et al wherein same would possess, for example, less gumminess (see Abstract).

5. Claims 19-21, 74-76, and 116-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldbrugge et al taken together with JP 58-28235.

The claims further call for the inclusion of a calcium source (e.g. calcium chloride). However, it is well known to employ calcium sources such as calcium chloride in extruded proteinaceous food products as taught, for example, by JP 58-28235. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included calcium chloride in the product of Feldbrugge et al for the reasons employed in JP 58-28235 and/or, simply, for calcium fortification of a food product.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-6, 13-26, 56-61, 68-82, and 109-119 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6607777. Although the conflicting claims are not identical, they are not patentably distinct from each other because the ranges of various components of the textured whey protein are not the same. In other words, although overlap exists, the scope of the instant claims and that of U.S. patent no. 6607777 are different. Nevertheless, such modifications in compositional amounts would have been well within the purview of a skilled artisan, and it would have been obvious to have arrived at same as a matter of preference in view of, for example, restriction in certain components and cost considerations in conjunction with routine experimental optimization therein.

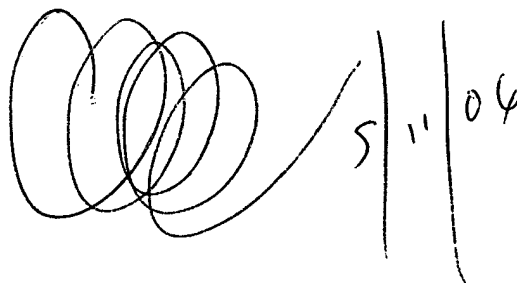
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier
Primary Examiner
Art Unit 1761

Anthony Weier
May 11, 2006

A handwritten signature consisting of several overlapping loops, followed by a vertical line and the date "5/11/06".